IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Dr. Al J. Mooney

Serial No.: 09/492,398

Filed: January 27, 2000

For: **Method of Supplying and Dispensing Prescribed Medical Supplies Through a Web Site Associated with a Medical Care Provider**

Attorney's Docket No: 4333-003

Patent Pending

Examiner: Samuel G. Rimell

Group Art Unit: 2165

Raleigh, North Carolina
May 19, 2005

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 19, 2005.

Kathy L. Stehle

RESPONSE TO COMMUNICATION MAILED APRIL 20, 2005

Dear Sir:

In reply to the Communication mailed April 20, 2005, Applicant respectfully submits a revised Appeal Brief. Specifically, the Appeal Brief was amended to remove Exhibits 1 and 2 as required by the Examiner. Additionally, the content of the Brief (i.e., pages 7 and 11) has been amended to delete the references to the Exhibits. Applicant believes that the revised Appeal Brief now fully complies with the submission requirements specified by 37 C.F.R. § 1.192, which were the rules that were in effect at the time the original Appeal Brief was filed. However, if the

Examiner disagrees, the Examiner is respectfully requested to contact the undersigned to discuss the matter further.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:

Stephen A. Herrera
Registration No. 47,642

P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
)
Mooney)
)
Serial No. 09/492,398) Rimell, Samuel G.
) Examiner
Filed: January 27, 2000) Group Art Unit 2165
) Conf. No. 9822
For: **METHOD OF SUPPLYING AND DISPENSING PRESCRIBED MEDICAL SUPPLIES THROUGH A WEB SITE ASSOCIATED WITH A MEDICAL CARE PROVIDER**)
)
Attorney's Docket No. 4333-003)

Raleigh, North Carolina
May 19, 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 19, 2005.

Kathy L. Stehle

REVISED APPEAL BRIEF

This revised appeal brief is being filed in triplicate responsive to the Communication mailed by the Office on April 20, 2005. The original Brief was filed prior to September 13, 2004. As such, this revised Brief is not required to conform to the format specified by 37 C.F.R § 41.37, but remains compliant with the format specified by 37 C.F.R. §1.192. No fees should be required for entry of this revised Brief. However, if any fees are due or required, Applicant requests that this be considered a Petition therefore, and the Commissioner is hereby authorized to charge Deposit Account 18-1167.

(1) REAL PARTY IN INTEREST

The real party in interest is Dr. Al J. Mooney, the inventor of the present application.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Applicant's knowledge.

(3) STATUS OF CLAIMS

A total of seventy-one (71) claims have been presented for examination. They are claims 1-71. During prosecution, claims 1-49 were cancelled without prejudice, and the remaining claims 50-71 were subject to a restriction requirement. The Group I claims include claims 50-67 and the Group II claims include claims 68-71. Applicant elected to prosecute with traverse the claims of Group I.

The Examiner has maintained the rejection of Group I claims 50-67 under 35 U.S.C. § 102(e) as being anticipated by the patent to Silver. Accordingly, Applicants appeal the Examiner's rejection from all rejected claims 50-67.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of Applicant's knowledge.

(5) SUMMARY OF INVENTION

The present invention relates to a system and method of prescribing, purchasing, and delivering medical supplies through an Internet website associated with a

prescribing medical care provider, wherein the prescribing medical care provider may be compensated for the purchase of the prescribed medical supply.

A medical care provider is associated with a network gateway, for example, a web page on the Internet, which includes a list of medical supplies that may be prescribed to a patient. In one embodiment, the web page contains visual representations and detailed descriptions of the medical supplies, as well as instructions on their use. The gateway is therefore a platform from which the patient may purchase a prescribed medical supply (spec., p. 2, ll. 10-17).

The medical care provider makes a diagnosis and prescribes a medical supply to treat the patient as a result of an appropriate medical examination (spec., p. 2, ll. 18-19; p. 3, ll. 17-18). Upon receiving the prescription, the patient may access the network gateway and select the prescribed medical supply (spec., p. 2, ll. 21-22). The gateway communicates the patient's selection to an appropriate medical supply vendor who fulfills the patient's order (spec., p. 2, l. 23 – p. 4, l. 1). In one embodiment, the order is communicated to an e-commerce provider who accepts payment for the prescribed medical supply from the patient, and forwards the order to the medical supply vendor (spec., p. 2, l. 23 – p. 4, l. 1). The medical supply vendor fulfills the order, and ships or delivers the prescribed medical supply to the patient via a suitable courier (spec., p. 3, ll. 3-7).

Payment for the prescribed medical supply ordered by the patient may initially be made to the e-commerce provider, the medical care provider, or the medical supply vendor (spec., p. 3, ll. 1-3). Once the prescribed medical supply is shipped to the patient, the payment may be split between the medical supply vendor, the e-commerce provider, and the medical care provider (spec., p. 3, ll. 3-5). That is, the respective accounts associated with each of the parties involved in the transaction may be credited

with at least a portion of the payment tendered for the prescribed medical supply (spec., p. 3, ll. 3-5; p. 7, l. 10 – p. 8, l. 4).

(6) ISSUES

Whether claims 50-67 are anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,269,339 to Silver (hereinafter "Silver").

(7) GROUPING OF CLAIMS

The claims should be grouped as follows:

Group I: Claims 50-51, 53, 55-56, 58-59, and 61.

Group II: Claim 52.

Group III: Claim 54.

Group IV: Claim 57.

Group V: Claim 60.

Group VI: Claims 62-63 and 67.

Group VII: Claim 64.

Group VIII: Claim 65.

Group IX: Claim 66.

All claims in each group stand or fall together.

(8) ARGUMENT

A. The Law of Anticipation

Anticipation under 35 U.S.C. § 102(e) requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 47 U.S.P.Q.2d 1027 (Fed. Cir. 1998). That is, every element and

limitation of the claim must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

While it is true that the PTO may give a claim its broadest reasonable meaning when determining patentability, *Burlington Industries, Inc., v. Quigg*, 822 F.2d 1581 (Fed. Cir. 1987), the Examiner cannot ignore the "reasonableness" limitation. In differentiating between reasonable and unreasonable interpretations, the basic rules of claim interpretation apply. First, terms in a claim must be given their plain and ordinary meaning unless the applicant has clearly provided a contrary definition in the specification. *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989). *See also*, MPEP § 2111.01. Second, terms and phrases of a claim must be construed in harmony with the Applicant's written description. "[The mandate of broadest reasonable interpretation during prosecution] does not relieve the PTO of its essential task of examining the entire patent disclosure to discern the meaning of claim words and phrases." *Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 970 F.2d 834 (Fed. Cir. 1992), *reh'g in banc denied*, 974 F.2d 1279 (Fed. Cir. 1992). Finally, the interpretation given to claim terms and phrases must be consistent with the interpretation that would be given by one skilled in the art. *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999). "It is axiomatic that, in proceedings before the PTO, . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). *See also*, MPEP § 2111.01.

B. Silver fails to anticipate claims 50-67 under 35 U.S.C. § 102(e)

Silver discloses an interactive wellness system that uses a computerized questionnaire system to collect and store various personal data about a user and the user's lifestyle. The personal data includes parameters such as the user's voluntary choices, habits, environment, disease transitions, and genetic predispositions. The

system of Silver uses the collected data to determine the user's physiological age and measure the user's wellness. *Silver*, col. 4, ll. 49-64. In addition, the system uses the collected data to generate specific wellness options for the user. Particularly, the disclosed system may offer suggestions, based on a set of pre-determined rules (i.e., a "knowledge base"), to assist the user in reaching a health-related goal. This includes links to certain products, such as vitamins and smoking-cessation aids. *E.g., Silver*, Figures 18-25. Once the user has chosen one of the wellness plans offered by the system, the user may periodically update his or her data to track their progress in reaching a certain wellness goal.

Group I

The Examiner has maintained the rejection to claim 50 under § 102(e) as being anticipated by Silver. For ease of reference, claim 50 appears below.

> 50. A method of prescribing and selling a medical supply through a website associated with a medical care provider comprising:
> conducting a medical examination on a patient, wherein the medical examination is conducted by the medical care provider;
> prescribing the medical supply for the patient, wherein the medical supply is prescribed by the medical care provider based on the results of the medical examination;
> accessing the website associated with the medical care provider, wherein the website includes an array of prescription medical supplies including the medical supply prescribed by the medical care provider;
> ordering the medical supply prescribed by the medical care provider from the website associated with the medical care provider; and
> wherein the medical care provider that prescribed the medical supply receives payment for the medical supply ordered from the website associated with the medical care provider.

The Examiner bases the rejection of claim 50 on the following postulations. First, that the automated questionnaire of Silver constitutes a "medical examination," and that a medical care provider conducts the medical examination because the medical care provider provides the questionnaire. Second, that the recommendations generated by

the interactive wellness system constitute a "prescription" for specific medical products and supplies based on a medical examination. Finally, that the medical care provider is paid for endorsing the recommended products. None of these contentions are valid.

Regarding the Examiner's first contention in more detail, claim 50 explicitly recites, "conducting a medical examination on a patient, wherein the medical examination is conducted by [a] medical care provider." It is well understood by those skilled in the art that a medical examination is specifically designed to elicit information regarding the state of a patient's health. Medical examinations include physical examinations and tests, and are performed by licensed medical care providers. In many cases, medical examinations result in a diagnosis and prescription. In other words, a medical examination is "an appropriate consultation" in which the medical care provider conducting the medical examination makes an informed medical judgment based on the circumstances of the situation, and on his or her training and experience. Indeed, the language in Applicant's specification adequately reinforces this meaning. *E.g., spec.*, pg. 2, ll. 18-19; *see also spec.*, pg. 3, ln. 18 – pg. 4, ln. 4. Additionally, Applicant's definition is consistent with the plain and ordinary meaning of the term. Any dictionary the Board would care to consult would define the term "medical examination" as defined by Applicant.

In supporting the rejection, the Examiner "considers" the questionnaire of Silver to be the requisite medical examination. However, this assertion is fundamentally flawed because it stands in stark contrast to the plain and ordinary meaning of the term "medical examination," and ignores what Applicant has explicitly stated the term to mean throughout prosecution. The Silver questionnaire includes a number of various common queries designed to elicit general information about a user's personal habits and demographics, which are used for marketing. As shown in Figures 3-6, the questionnaire of Silver posits generalized queries such as "Do you wear a seatbelt," and

"How often do you eat breakfast." Other questions may also be asked. However, the types of questions in the questionnaire are indicative of nothing more than common-sense queries that are applicable to most if not all of the population. They are specifically designed to obtain only general information used in determining a user's physiological age, ***not*** the source of a particular problem or ailment afflicting the patient.

> The present invention stratifies users into graded levels of health using a substantial range of wellness factors. The system then evaluates this stratification data and compares it to curves of similar factors for specific age groups. The curves which are closest to the calculated factors for the individual are a meaningful measurement of the equivalent physiological age of the individual.

Silver, col. 5, ll. 40-45 (emphasis added).

As evidenced by this passage, the system of Silver stratifies collected data and compares the answers provided by one user to data entered by other users in other age groups. The system then provides a "best fit" determination of a user's physiological age with respect to the stratified data. In other words, the system of Silver simply lumps users into generalized collective groups according to lifestyle similarities. Plainly, however, it says nothing about a particular ailment the user may or may not have, and is not an informed medical judgment based on the circumstances and the experience of the medical care provider. Indeed, those skilled in the art would never "consider" the questionnaire of Silver to constitute the requisite "medical examination."

Another reason the Examiner's contention fails is that it incorrectly theorizes that, because the doctor's name is on the opening screen of the display (see Figure 2 of Silver), the doctor "conducts a medical examination." This theorization pre-supposes that the questionnaire is a medical examination, which as explained above it is not. Even if, *arguendo*, the questionnaire of Silver could be considered a medical examination, the doctor in Silver never poses the questions to the patient. Instead, the computer does. The system of Silver is an *automated* computerized questionnaire that

does not require the presence of a doctor or other medical care provider to operate. Indeed, the system of Silver could be stored on a compact disk, for example, and run on a user's home computer. It collects data directly from a patient, and is completely autonomous with respect to the interpretations of that data. Applicant respectfully directs the Board's attention to the bottom of Figures 18-25 where a note is included to the user to *consult a doctor* before starting any of the wellness strategies "recommended" by the system. Indeed, if the doctor in Silver conducted an examination and prescribed a medical supply as recited by claim 50, *there would be no need for the disclosed system to explicitly tell a user to consult a physician.*

In conducting the requisite medical examination of claim 50, the medical care provider establishes a relationship based fundamentally on a patient's trust. A doctor, for example, establishes a "physician-patient" relationship during the medical examination upon which diagnosis, treatment, and continued care are based. This type of relationship is something that an automated system simply cannot provide. Applicant unambiguously defines the term "medical care provider" on page 3 of the specification, lines 18-21. "The disclosure will speak in terms of the medical care provider being a doctor, but it should be appreciated that other medical professionals such as nurse practitioners, physician assistants, chiropractors, or the like may all fall under the title medical care provider." An automated computerized questionnaire simply does not fall within the realm of a medical care provider – not by its plain and ordinary meaning, not as explicitly defined by Applicant, and certainly not as those skilled in the art would understand a medical care provider to be. Silver simply fails to disclose a doctor conducting a medical examination as recited in claim 50.

Regarding his second contention, the Examiner theorizes that because the system of Silver provides recommendations to the user, it necessarily "prescribes" a remedy. Claim 50 recites "prescribing the medical supply for the patient, wherein the

medical supply is prescribed by the medical care provider based on the results of the medical examination." Respectfully, the Examiner's interpretation is fundamentally flawed at least because it ignores Applicant's clear definition of the term "prescribing."

Applicant's specification clearly defines the meaning of the term "prescribe" on page 4 of the specification, lines 3-4. "...as used herein 'prescribe' shall be interpreted as 'to designate or order the use of as a remedy.'" As noted above, prescriptions are the result of a medical examination with a medical care provider who makes a diagnosis considering the patient's unique circumstances and the sum of his or her experience. Thus, the prescriptions of Applicant's claims are specific orders directed to a specific user by a medical care provider, resulting from a medical examination.

The "recommendations" of Silver, however, have no such specificity. The system of Silver makes recommendations to the user based on the user's answers to the questions. The recommendations do not "designate or order the use of as a remedy" as explicitly defined by Applicant. In sharp contrast, they are merely canned suggestions based on a set of predetermined rules and answers to a set of general questions provided by the user that assist a user in realizing a long term wellness goal. "Personal profile characteristics include age, life style, habit/environment, medical and genetic information about a user. Personal profile characteristics are used to stratify a user into a correct relative probability group, personalize recommendations and educators, and provide information to system and business functions." *Silver*, col. 8, ln. 63 – col. 9, ln. 1 (emphasis added). As previously stated, the system of Silver makes a "best guess" that lumps users into "probability" groups, and uses information about these groups to make a suggestion – a suggestion that may be accurate for all members of the group.

For example, Figures 18-25 illustrate some of the recommendations and wellness plans the Examiner equates to the claimed "prescription."

1. Cigarette Smoking: Commit to stop smoking or if you already have keep up the good work.
2. Cholesterol and HDL: If cholesterol is high or your HDL is low reduce your dietary cholesterol, exercise and have 1 alcoholic drink a night.
3. Blood Pressure: Reduce you blood pressure to LESS than 120/80."

Silver, Fig. 22. Plainly, these types of recommendations of Silver are no more than "common sense" suggestions that are equally applicable to many members of many groups. These suggestions use indefinite language (i.e., "**if** this, then do that **or** the other"), which does not teach, "designate or order the use of as a remedy," regardless of their content.

The fact that the computer recommends that a user stop smoking or take vitamins simply does not equate to a prescription. These are nothing more than common sense suggestions. In Silver, a doctor does not provide these suggestions based on a proper medical examination and diagnosis. Rather, the user in Silver is able to simply purchase items from vendors via the Internet, for example, based solely on the generalized output of the computer. The Board should take Official Notice that many medical boards throughout the country explicitly prohibit prescriptions for a patient without a licensed medical care provider first having conducted a medical examination on the patient. Medical boards view prescriptions for individuals that the medical care provider has never met, and which is based only on sets of computerized questions – as is done in Silver - as inappropriate and unprofessional. The North Carolina State Medical Board is one such medical board.

Regarding the final contention, the Examiner postulates that the doctor in Silver receives payment for endorsing the recommended products. Claim 50 explicitly recites that "the medical care provider that prescribed the medical supply receives payment for the medical supply ordered from the website associated with the medical care provider." In this context, the medical care provider receives compensation (e.g., money) for the purchase of the prescribed medical supply from the medical supply vendor.

The Examiner cites column 19 of Silver, lines 1-7, to support the assertion that Silver anticipates this limitation. This passage discloses that a system manager endorses the products for a fee that is paid to a system operator if the products meet the needs of the users. Importantly, however, there is no indication in the patent to Silver as to who the system managers and operators are. Silver *never* defines the doctor or the doctor's office as being either the system manager or the system operator. Indeed, this is the first – and last – mention of any such fee arrangement. Even if, *arguendo*, this passage could be interpreted as the Examiner asserts, it still does not anticipate claim 50. For the reasons stated above, the user in Silver receives a "recommendation" by answering a set of pre-determined questions posited by an "automated computer system." As such, whatever compensation the doctor may or may not receive does not come from a "prescription" resulting from a "medical examination" conducted by a "medical care provider." The Examiner's assertion – that the doctor receives payment – is an assumption that simply finds no concrete support in Silver.

It appears that in making the rejection, the Examiner has ignored the meanings explicitly given to the terms noted above in Applicant's specification, and instead, has assigned unduly broad, speculative, and unsupported interpretations. While it is true that the Examiner may give the claims their broadest reasonable meaning, he cannot ignore the "reasonableness" directive, and it certainly cannot ignore Applicant's specification. "[The mandate of broadest reasonable interpretation during prosecution] does not relieve the PTO of its essential task of examining the entire patent disclosure to discern the meaning of claim words and phrases." *Atlantic Thermoplastics Co., Inc. v. Faytex Corp.*, 970 F.2d 834 (Fed. Cir. 1992), *reh'g in banc denied*, 974 F.2d 1279 (Fed. Cir. 1992). Further, it is paramount that the interpretation given to claim terms and phrases must be consistent with the interpretation that would be given by one skilled in the art. *In re Cortright*, 165 F.3d 1353 (Fed. Cir. 1999). "It is axiomatic that, in

proceedings before the PTO, . . . claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990). *See also*, MPEP § 2111.01.

For the reasons stated above, Silver simply fails to anticipate claim 50 under § 102(e). Further, the rejections put forth by the Examiner fail to comport with the legally mandated guidelines. The rejections fail to consider the plain and ordinary meaning of the claim terms, Applicant's definitions in the specification, and what is understood by those skilled in the art. Thus, the claims have not been interpreted as required by the law. Therefore, the rejection to claim 50 under 35 U.S.C. § 102(e) as being anticipated by Silver is improper. Accordingly, Silver fails to teach claim 50 under 35 U.S.C. § 102(e).

Group II

The Examiner also rejected claim 52 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 52 appears below.

> 52. The method of claim 51 wherein the medical supply vendor is a supplier of medical devices.

Claim 52 depends indirectly from claim 50, and thus, is patentably distinguished over Silver for all the reasons stated above. However, claim 52 is patentable for at least an additional reason.

Particularly, in addition to medical supplies, claim 52 recites that the medical supply vendor also supply "medical devices." Applicant's specification unambiguously defines the term "medical device" beginning on page 3, line 22. "As used herein, the term 'medical device' includes the class of products such as crutches, slings, splints, bandages, walkers, prostheses, and the like." In rejecting claim 52, the Examiner theorizes that because Figure 19 of Silver identifies vitamins as being a product sold

through a website, it necessarily discloses "medical devices." "[V]itamins or packages of vitamins are considered readable as devices for medical purposes." *See Final Office Action dated February 18, 2004*, pg. 3. However, scrutiny of the Silver patent fails to reveal any passage that would lend support to this assertion.

The Figure cited by the Examiner illustrates a "Wellness Planner" that lists several recommendations for the user to consider. The user may find products associated with each of the recommendations. However, none of the recommendations appear to be anything that would require or suggest that the user purchase a "medical device." Rather, the products include vitamins, smoking cessation aids, and information for weight loss and heart rate activity. Silver never mentions that the user can purchase any type of medical device as Applicant defines that term in claim 52, and never even suggests that vitamins are or should be considered "medical devices." This is because the system of Silver bases its recommendations on answers to general questions and not on a medical examination personally given by a medical care provider. Thus, the system of Silver would have no basis for prescribing the use of a medical device to a patient.

Respectfully, the rejection to claim 52 appears based on an arbitrary meaning given to the term "medical device" that is inconsistent with what is known in the art as well as with Applicant's explicit definition. As stated above, this is legally improper claim interpretation. Medical devices are products such as crutches, slings, splints, bandages, walkers, prostheses, and other devices. Vitamins, individual or otherwise, are not included in this list, nor would anyone skilled in the art consider them to be. It is improper as a matter of law for the Examiner to read this as such. Therefore, Silver fails to anticipate claim 52 under § 102(e) for at least this additional reason.

Group III

The Examiner also rejected claim 54 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 54 appears below.

> 54. The method of claim 51 wherein the medical supply vendor is the medical care provider.

Claim 54 depends indirectly from claim 50, and thus, is patentably distinct for all the same reasons as stated above. Further, however, claim 54 additionally recites that the medical supply vendor is the *same entity* as the medical care provider. In other words, the entity vending the supplies is the same entity performing the examination and prescribing the supplies.

The Examiner asserts that Silver discloses this limitation in column 19, lines 1-7. The assertion is incorrect. Scrutiny of this passage reveals that a system manager (whoever that may be) could endorse the products for a fee – a fee that is paid to a *separate* system operator (whoever that may be). As previously stated, there is no indication in Silver as to whom these entities represent. As such, there is no basis for the contention that these entities represent *both* the medical care provider and the medical supply vendor, and further, that they are one in the same entity. Even assuming *arguendo* that the doctor in Silver does receive payment for endorsing the products (which he does not), there is no indication that the doctor vends the products recommended. If anything, the opposite appears to be the case.

> Alternatively, in the event that a user selects a particular factor to evaluate, the factor database will also contain a universal resource locator (URL) database 2508. This database would comprise Internet addresses for merchants that provide products associated with the factor being evaluated. The user could thus click on the factor noted in the factor database 2504, be taken to the appropriate URL address in the URL database 2508.

Silver, col. 17, ln. 65 - col. 18, ln. 5 (emphasis added). The website of Silver may contain links to various merchants, but it is the *merchants* that sell the medical supplies

in Silver, *not* the medical care provider. Further, the suggested products have nothing to do with the medical provider's examination, diagnosis, and prescription. Rather, they relate to the specific factor being evaluated. There is no indication whatsoever in Silver that the medical care provider sells these products. All that the Silver system does is provide links to products related to the factor being evaluated by the system. Silver simply does not teach that the prescribing physician also vends the medical supplies. Therefore, Silver fails to anticipate claim 54 under § 102(e).

Group IV

The Examiner also rejected claim 57 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 57 appears below.

> 57. The method of claim 56 wherein the e-commerce provider is the medical care provider.

Claim 57 depends indirectly from claim 50, and as such, is patentable over Silver for the same reasons as stated above with respect to claim 50.

In addition, however, Silver fails to disclose that an e-commerce provider credits or debits the account of the medical supply vendor for the sale of the prescribed medical supply or device, wherein the e-commerce provider and the medical care provider are the same entity. The only thing the Examiner states in the Office Action is that "[t]he e-commerce provider is the physician and the physician's associated website." *Final Office Action*, February 18, 2004, pg. 4. The Examiner provides no reasoning or evidence of record that would lend credence to the assertion.

This is because the patent to Silver does not teach this limitation. Indeed, Silver lacks any support for the rejection. The Examiner cites column 19, lines 1-7, in rejecting claim 56 (from which claim 57 depends), however, even given the broadest reasonable interpretation, this passage of Silver does not anticipate claim 57. Applicant previously

noted that this passage discloses nothing more than the fact that a system manager and a system operator (two distinct entities) may receive a fee for endorsing the products. There is no indication as to who these entities represent, and certainly no indication of who pays these entities.

The Examiner may not base a rejection on mere speculation and unsupported innuendo, but rather, bears the initial burden of factually supporting any prima facie case of obviousness. *See*, MPEP § 2142. Silver does not teach claim 57, and the Examiner never indicates any concrete evidence of record to show that it does.

> To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Ex parte Levengood, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Inter. 1993) (emphasis added). The rejection to claim 57 is based only on a statement provided by the Examiner that could only have come from Applicant's own specification. As such, Silver fails to anticipate claim 57 under § 102(e).

Group V

The Examiner also rejected claim 60 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 60 appears below.

> 60. The method of claim 55 wherein the e-commerce provider credits or debits an account associated with the medical supply vendor and an account associated with the medical care provider for the sale of the medical supply prescribed by the medical care provider.

Claim 60 depends indirectly from claim 50, and as such, is patentable over Silver for the same reasons as stated above with respect to claim 50. Additionally, however, claim 60 recites that an e-commerce provider credits or debits *both* an account associated with the medical supply vendor *and* an account associated with the medical care provider.

The Examiner never provides a specific rationale supporting the rejection of claim 60, but instead, relies on the reasoning for the rejection of claim 56. However, claim 56 recites only that an e-commerce provider credit or debit the account of the medical supply vendor. It says nothing about crediting or debiting the account of the medical care provider *in addition to* the account of the medical supply vendor. Thus, the rejection of claim 60 is not based on the subject matter of claim 60. Rather, it is based on the language of completely separate claim 56.

Silver does not disclose that an e-commerce provider credit or debit the account of the medical care provider. Again, the Examiner relies on column 19 of Silver, lines 1-7 (see the rejection to claim 56). However, this passage says nothing about who the entities are, how they are paid, or what entity (i.e., an e-commerce provider) pays them. It certainly does not disclose that an e-commerce provider credits or debits *both* of the requisite accounts. In fact, Silver never even suggests that an e-commerce entity is contemplated. As such, Silver fails to teach claim 60 under § 102(e).

Group VI

The Examiner also rejected claim 62 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 62 appears below.

> 62. A method of prescribing and selling a medical supply through a website associated with a medical care provider comprising:
> conducting a medical examination on a patient, wherein the medical examination is conducted by a medical care provider having a website;
> prescribing a medical supply for the patient, wherein the medical supply is prescribed by the medical care provider based on the results of the medical examination;
> providing access to the website associated with the medical care provider, wherein the website includes an array of prescription medical supplies including the medical supply prescribed by the medical care provider;
> wherein the medical care provider that prescribed the medical supply receives an order through the website for the medical supply; and

wherein the medical care provider that prescribed the medical supply receives payment for the medical supply ordered from the website associated with the medical care provider.

Claim 62 is the independent claim of Group 6. Like claim 50, claim 62 recites the limitations that a medical care provider conducts a medical examination, and prescribes a medical supply based on the results of the medical examination. Claim 62 also recites that the medical care provider receive payment for the prescribed medical supply purchased through the website from the medical supply vendor. Each of these limitations of claim 62 was discussed above with respect to claim 50, and as such, need not be detailed further. Claim 62 is patentably distinct for at least the reasons stated above with respect to claim 50.

In addition, however, claim 62 also recites "wherein the medical care provider that prescribed the medical supply receives an order through the website for the medical supply." Thus, the medical care provider of claim 62 not only conducts the medical examination and prescribes the medical supply, but also receives the order from the user for the prescribed medical supply. In contrast to the Examiner's assertions, Silver simply does not teach this claimed limitation.

In his reasoning supporting the rejection to claim 62, the Examiner simply points to the rationale given for claim 50. However, claim 50 *does not* recite this limitation. Claim 50 recites only that the user order the prescribed medical supply from the website associated with the medical care provider (which Silver fails to teach). It does not recite that the medical care provider receives the order for the medical supply. Thus, in rejecting claim 62, the Examiner has failed to consider each of the claimed limitations as is required by law. This, by itself, is enough of a reason to overturn the rejection to claim 62.

In addition, however, Silver simply fails to disclose that the medical care provider receives the order for the prescribed medical supply. Silver discloses only that a user

can click on links to the websites of vendors (i.e., not the doctor) that may provide information and supplies relating to a factor being evaluated. Silver never discloses that the doctor, or any one other than a product vendor, receives an order for a product, and the Examiner never asserts that it does. In fact, Silver never even discloses that the doctor vends medical supplies or devices.

As the Board is aware, anticipation of claim 62 recites the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Rockwell Intern. Corp. v. U.S.*, 147 F.3d 1358, 47 U.S.P.Q.2d 1027 (Fed. Cir. 1998). That is, every element and limitation of the claim must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). In this case, the Examiner has failed to support the rejection. Silver fails to disclose each and every element of claim 62, and the Examiner never asserts that it does. Instead, the Examiner merely rejects claim 62 with an apparent "hand-wave" and a statement that says nothing more than "see claim 50." The rejection of claim 62 is speculative and unsupported by the Silver patent. The only support for the Examiner's assertion is in Applicant's own specification. This is improper analysis as a matter of law, and for this reason alone the § 102(e) rejection should be withdrawn.

Group VII

The Examiner also rejected claim 64 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 64 appears below.

> 64. The method of claim 63 wherein the e-commerce provider credits or debits an account associated with the medical care provider that prescribed the medical supply for the sale of the medical supply.

Claim 64 depends indirectly from claim 62, and as such, is patentable over Silver for reasons discussed above.

Additionally, however, claim 64 recites that an e-commerce provider credit or debit the account associated with the medical care provider that prescribed the medical supply for the purchase of the medical supply. Again, the Examiner simply points to the reasoning put forth to support the rejection of claim 56, specifically stating that the physician would "inherently receive money into [the] physician's account from the medical supply vendor." However, claim 56 recites that the e-commerce provider credit or debit the account of the medical supply vendor – not the medical care provider. Thus, the rejection of claim 64 is not based on the claimed limitations.

Silver does not teach that an e-commerce provider credits or debits the doctor's account for the purchase of the prescribed medical supply, and it is not inherent that the doctor in Silver would receive money in his account. As previously stated, the passage continually relied on by the Examiner (i.e., column 19, lines 1-7), discloses only that a system manager and a system operator may receive a fee, with no indication of who they are, and no indication of who pays them. The rejection of claim 64 is speculative at best, and has no concrete support in the cited reference. Accordingly, claim 64 is patentable distinct over the patent to Silver.

Group VIII

The Examiner also rejected claim 65 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 65 appears below.

> 65. The method of claim 63 wherein the e-commerce provider is the medical care provider.

Claim 65 depends indirectly from claim 62, and as such, includes all the limitations of claim 62. Therefore, Silver necessarily fails to anticipate claim 65 under § 102(e).

Additionally, however, claim 65 recites that the medical care provider also act as the e-commerce provider. Thus, the medical care provider of claim 65 conducts the

examination, prescribes the medical supply based on the examination, provides the medical supply, and arranges payment with the user for the prescribed medical supply. The Examiner simply points to the reasoning of claim 57, which as stated above, is nothing more than a conclusionary statement unsupported by either the reference or the Examiner. As previously stated, this type of reasoning amounts to a *legally improper* § 102(e) analysis, and as such, cannot be permitted to stand.

Simply put, Silver teaches that a user can go to a vendor's website to purchase items such as over-the-counter vitamins or smoking cessation aids, but does not disclose that the doctor is the e-commerce provider. There is no indication that the doctor in Silver arranges for payment from the user for a prescribed medical supply. At most, the computerized questionnaire in Silver provides a link to products of other vendors. How the users purchase the desired products is completely outside the scope of the Silver patent. The doctor never receives an order for the recommended supply, and certainly does not arrange for payment from the user. Accordingly, claim 65 is patentably distinct over Silver.

Group IX

The Examiner also rejected claim 66 under 35 U.S.C. § 102(e) as being anticipated by Silver. For reference, claim 66 appears below.

> 66. The method of claim 62 wherein the medical care provider is a licensed medical care professional.

Claim 66 depends directly from claim 62, and as such, includes all the limitations of claim 62. Therefore, Silver necessarily fails to anticipate claim 65 under § 102(e).

However, claim 62 explicitly recites that the medical care provider of claim 62 is a "licensed medical care professional." Thus, the licensed medical care professional (e.g., a doctor) conducts the examination, prescribes a medical supply based on the

results of the examination, receives an order from the patient for the prescribed medical supply, and receives payment from the patient for the purchase of the prescribed medical supply. Silver may disclose a doctor, and further, that the system may be physically located in a health-care facility or other office. However, Silver does not disclose that a doctor perform these steps of method claim 62. In contrast, the computer system acts autonomously to collect and maintain information from the user without ever having the need for the presence of a doctor or any other "licensed medical care professional." Any recommendations or personalized wellness plans are products of the system's knowledge base, and from comparisons of the user's answers to those provided by previous users in similar physiological groups. Evidence that the computerized questionnaire in Silver operates discretely from a "licensed medical care professional" can be seen in Figures 18-25 of Silver, for example, where the system recommendations and planning screens include explicit language telling the user to consult a doctor prior to beginning a wellness plan. Accordingly, claim 66 is patentably distinct over the patent to Silver.

Conclusion

For the reasons stated above, the patent to Silver fails to anticipate any of Applicant's claims under 35 U.S.C. § 102(e). Accordingly, the rejections should be withdrawn.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By:

Stephen A. Herrera
Registration No. 47,642
P.O. Box 5
Raleigh, NC 27602
Telephone: (919) 854-1844

(9) APPENDIX

CLAIMS

1-49. (Canceled).

50. A method of prescribing and selling a medical supply through a website associated with a medical care provider comprising:

conducting a medical examination on a patient, wherein the medical examination is conducted by the medical care provider;

prescribing the medical supply for the patient, wherein the medical supply is prescribed by the medical care provider based on the results of the medical examination;

accessing the website associated with the medical care provider, wherein the website includes an array of prescription medical supplies including the medical supply prescribed by the medical care provider;

ordering the medical supply prescribed by the medical care provider from the website associated with the medical care provider; and

wherein the medical care provider that prescribed the medical supply receives payment for the medical supply ordered from the website associated with the medical care provider.

51. The method of claim 50 wherein ordering the medical supply prescribed by the medical care provider from the website comprises ordering the medical supply from a medical supply vendor that fulfills the order placed through the website associated with the medical care provider.

52. The method of claim 51 wherein the medical supply vendor is a supplier of medical devices.

53. The method of claim 51 wherein the medical supply vendor is a supplier of pharmaceutical products.

54. The method of claim 51 wherein the medical supply vendor is the medical care provider.

55. The method of claim 51 further comprising arranging payment through an e-commerce provider for the medical supply prescribed by the medical care provider.

56. The method of claim 55 wherein the e-commerce provider credits or debits an account associated with the medical supply vendor for the sale of the medical supply prescribed by the medical care provider.

57. The method of claim 56 wherein the e-commerce provider is the medical care provider.

58. The method of claim 55 wherein the e-commerce provider credits or debits an account associated with the medical care provider that prescribed the medical supply for the sale of the medical supply.

59. The method of claim 58 wherein the e-commerce provider is the medical supply vendor.

60. The method of claim 55 wherein the e-commerce provider credits or debits an account associated with the medical supply vendor and an account associated with the medical care provider for the sale of the medical supply prescribed by the medical care provider.

61. The method of claim 50 wherein the medical care provider is a licensed medical care professional.

62. A method of prescribing and selling a medical supply through a website associated with a medical care provider comprising:

conducting a medical examination on a patient, wherein the medical examination is conducted by a medical care provider having a website;

prescribing a medical supply for the patient, wherein the medical supply is prescribed by the medical care provider based on the results of the medical examination;

providing access to the website associated with the medical care provider, wherein the website includes an array of prescription medical supplies including the medical supply prescribed by the medical care provider;

wherein the medical care provider that prescribed the medical supply receives an order through the website for the medical supply; and

wherein the medical care provider that prescribed the medical supply receives payment for the medical supply ordered from the website associated with the medical care provider.

63. The method of claim 62 further comprising arranging payment through an e-commerce provider for the medical supply prescribed by the medical care provider.

64. The method of claim 63 wherein the e-commerce provider credits or debits an account associated with the medical care provider that prescribed the medical supply for the sale of the medical supply.

65. The method of claim 63 wherein the e-commerce provider is the medical care provider.

66. The method of claim 62 wherein the medical care provider is a licensed medical care professional.

67. The method of claim 62 wherein providing access to the website associated with the medical care provider comprises maintaining a website on the World Wide Web.

68-71. (Withdrawn).